

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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MAILED

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JONATHAN W. HAINES  
and  
STEVEN S. WILLIAMS

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Application 09/894,821

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on October 18, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the Image File Wrapper (IFW) indicates that in the Final Rejection mailed April 20, 2004, the following § 103 rejections were made:

1. Claims 1, 2, 9, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krantz et al., U.S. Patent 6,530,000 B1, in view of Berning et al., U.S. Patent 6,038,619 [page 2]; and

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krantz et al., U.S. Patent 6,530,000 B1, in view of Berning et al., U.S. Patent 6,038,619, and further in view of Tamura, U.S. Patent 6,389,508 B1 [page 3].

The Examiner's Answer mailed December 2, 2004 determined that, after further consideration, the appeal involves only claim 9. The Answer listed the sole rejection as follows:

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krantz et al., U.S. Patent 6,530,000 B1, in view of Berning et al., U.S. Patent 6,038,619, and Goodwin et al., US Patent 5,659,713 (as evidentiary support for streaming data requiring sequential access) [page 2].

It should also be noted that Goodwin et al. was included under "Prior Art of Record". Because of the inclusion of the Goodwin et al. reference, this rejection appears to be a new ground of rejection. While a new ground of rejection is permitted in the Examiner's Answer, the examiner must follow the guidelines set forth in the training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section,  
and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed December 2, 2004. Once the Examiner's Answer mailed December 2, 2004 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

In addition, appellants filed an Appeal Brief on September 22, 2004 using the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on

September 13, 2004, and replaced by 37 CFR § 41.37(c).

Accordingly, the Appeal Brief does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified

under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or

authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to

unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

An in-depth review of the Appeal Brief filed September 22, 2004 indicates that the following sections are missing:

- 1) "Summary of claimed subject matter," as set forth in 37 CFR § 41.37(c)(1)(v);
- 2) "Grounds of rejection to be reviewed on appeal," as set forth in 37 CFR § 41.37(c)(1)(vi);
- 3) "Claims appendix," as set forth in 37 CFR § 41.37(c)(1)(viii);
- 4) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 5) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

In addition, the Examiner's Answer mailed December 2, 2004 does not comply with the headings set forth in the new rules under 37 CFR § 41.37(c). Correction is required.

Accordingly, it is

ORDERED that the application is returned to the  
Examiner:

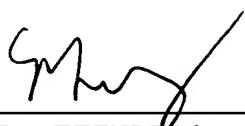
- 1) to hold the Appeal Brief filed September 22, 2004 defective;
- 2) for notification to appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for consideration of the substitute Appeal Brief;
- 4) to vacate the Examiner's Answer mailed December 2, 2004 and:
  - a. to select one of the following options:
    - i. reopen prosecution;
    - ii. write a new Examiner's Answer without the new grounds of rejection; or
    - iii. write a new Examiner's Answer properly setting forth the new ground of rejection; and
  - b. to issue a new Examiner's Answer in compliance with the new rules which became effective on September 13, 2004;
- 5) to have a complete copy of any subsequent Examiner's Answer scanned into the IFW; and

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6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

  
CRAIG R. FEINBERG  
Program and Resource Administrator  
(571) 272-9797

CRF:psb

cc: Seagate Technology LLC  
c/o Westman Champlin & Kelly, P.A.  
Suite 1400 - International Centre  
900 Second Avenue South  
Minneapolis, MN 55402-3319